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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 26

Application Number: 08/787,893
Filing Date: 01/23/97
Appellant(s): Kevin B. McNeil

Larry L. Huston
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed June 15, 1998.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: 1773

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 2-8.

Claim 1 has been canceled.

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The examiner agrees that the claims stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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(10) No New Prior Art

No new prior art has been applied in this examiner's answer.

Claims 2-8 stand finally rejected under 35 USC 103 as being patentable over the patent to Matsumoto et al.

Matsumoto et al. teach a core wound paper product comprising a sheet having a principal direction and length. The sheet bears spaced apart indicia and has lines of termination transverse to the principal direction.

The experimental modification of this prior art in order to ascertain optimum operating (e.g., determine the precise location of the indicia and the lines of termination) fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. Registration of the repeating indicia with the lines of termination constitute an obvious design choice. Why would you want to produce a product where the indicia unaesthetically don't align or register with the lines of termination? Obviously, the product where the indicia and the lines of termination are in registry would be more desirable.

(11) Response to Argument

Appellant's argument is simple: The process employed by Matsumoto et al. cannot produce a continuous length of printed paper where the indicia and lines of termination are applied simultaneously.

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This was a relevant argument in appellant's parent case which was directed to a process of use. Unfortunately, the instant application is directed to an article which in its simplest form comprises a length of paper bearing indicia in registry with lines of termination. The third paragraph in column 1 of Matsumoto et al. clearly describes a printed length of paper which has lines of termination applied in registry with the indicia. The fact that the printing and lines of termination are not applied simultaneously is not dispositive of the issue of patentability of the instant article claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Hess/maj
September 16, 1998

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